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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,024	05/23/2001	Ryuichi Maeda		7277

7590

09/08/2004

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EXAMINER
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COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/863,024	Applicant(s) MAEDA ET AL.	
	Examiner Kenneth R Coulter	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ✓  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.   |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 - 9, drawn to protocol conversion, classified in class 709, subclass 232.
  - II. Claims 10 - 20, drawn to storage of user settings, classified in class 709, subclass 220.
  
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group I) as claimed does not require the particulars of the subcombination as claimed because protocol conversion does not require the storage of user settings in order to be operational. The subcombination (Group II) has separate utility such as the storage and recovery of user setting information from an appliance.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Felix J. D'Ambrosio (Reg. No. 25,721) on 8/27/04 a provisional election was made *with traverse* to prosecute the invention of Group I, claims 1 - 9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10 – 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

7. Claim 7 recites the limitation "said individual communication address" in lines 4 -

5. There is insufficient antecedent basis for this limitation in the claim (with regard to claim 1).

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 - 9 are rejected under 35 U.S.C. 102(e) as being disclosed by Sharood et al. (U.S. Pat. No. 6,453,687) (Refrigeration Monitor Unit).

9.1 Regarding claim 1, Sharood discloses a communication network-adapted protocol conversion connector adapted for attaching to a communication network laid in

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buildings such as office building, dwelling house and the like, said connector comprising:

a primary connecting portion to be connected to said communication network laid indoors (Figs. 1, 6a-6d; col. 5, lines 12 - 17);

a secondary connecting portion to be connected to a network-adapted appliance (Figs. 1, 6a-6d; col. 5, lines 12 - 17);

a protocol conversion interface to convert the protocol for control signals to be sent and received between said communication network and said network-adapted appliance (Fig. 6a; col. 5, lines 1 – 17 “smart modules, retrofit plugs, and universal controllers may be used to provide the function of protocol conversion.” ); and

a feeder connecting portion to feed electric power to said network-adapted appliance to be connected to said secondary connecting portion (Figs. 1, 6a-6d; col. 2, lines 25 – 26; col. 4, lines 17 – 25).

9.2 Per claim 2, Sharood teaches the connector of claim 1, wherein said communication network comprises an information wire laid indoors and connected to a communication server, wherein said primary connecting portion is connected to said information wire while said secondary connecting portion is connected to said network-adapted appliance, and wherein said protocol conversion interface is set an individual communication address and converts the protocol for control signals to make it possible to send and receive said control signals between said network-adapted appliance connected to said secondary connecting portion and said communication server

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connected to said information wire, further wherein said feeder connecting portion supplies said network-adapted appliance with electric power from a power line laid indoors (Fig. 1, item 3; Figs. 6a-6d; Fig. 12; col. 3, lines 63 – 64; col. 5, lines 1 – 17).

9.3 Regarding claim 3, Sharood discloses the connector of claim 1, further comprising a control information/power sending and receiving circuit, wherein said communication network comprises a power line laid indoors and connected to a communication server, for sending power line carrier signals which are superimposed with control signals and power source, wherein said primary connecting portion is connected to said power line while said secondary connecting portion is connected to said network-adapted appliance, and wherein said control information/power sending and receiving circuit separates control signals and power source from said power line carrier (PLC) signals, sent in through said power line and sends back the control signals, superimposed with said power line carrier signals, sent out from said network-adapted appliance through said secondary connecting portion, further wherein said protocol conversion interface is set an individual communication address, converts the protocol for control signals to make it possible to send and receive the control signals between said network-adapted appliance connected to said secondary connecting portion and said communication server connected to said power line and said feeder connecting portion supplies said network-adapted appliance with electric power separated by said control information/power sending and receiving circuit (Fig. 1, item 3; Figs. 6a – 6d; Fig. 12; col. 2, lines 16 – 26; col. 3, lines 58 – 67; col. 5, lines 12 - 14).



9.4 Per claim 4, Sharood teaches the connector of claim 1, wherein said communication network comprises a **wireless** communication network for sending and receiving radio signals superimposed control signals therewith between a wireless communication server installed indoors, wherein said primary connecting portion constitutes a wireless signal processing unit for sending and receiving radio signals superimposed the control signals therewith between said wireless communication server while said secondary connecting portion is connected to said network-adapted appliance, and wherein said protocol conversion interface is set an individual communication address and converts the protocol for control signals to make it possible to send and receive the control signals between said network-adapted appliance connected to said secondary connecting portion and said wireless communication server, further wherein said feeder connecting portion supplies said network-adapted appliance with electric power from a power line laid indoors (Fig. 1, item 4; Figs. 6a-6d; Fig. 12; col. 3, lines 63 – 64; col. 5, lines 1 – 17).

9.5 Regarding claim 5, Sharood discloses the connector of claim 2 or 3, further comprising a power cut-off circuit which is controlled by the control signals sent in through said information wire or said power line or by the control signals sent in from said network-adapted appliance connected to said secondary connecting portion (col. 10, lines 9 – 16 “remote shutdown of the attached appliance” ; col. 17, lines 9 – 12; col. 18, lines 41 – 44; col. 19, lines 49 - 51).

9.6 Per claim 6, Sharood teaches the connector of claim 4, further comprising a power cut-off circuit which is controlled by the control signals sent in through said wireless communication server or by control signals sent in from said network-adapted appliance connected to said secondary connecting portion (Fig. 1, item 4; col. 8, lines 43 – 45 “the plug may be incorporated in a **wireless network 4** for monitoring and **control** of an associated **appliance**.” ; col. 10, lines 9 – 16 “**remote shutdown** of the attached appliance” ; col. 17, lines 9 – 12; col. 18, lines 41 – 44; col. 19, lines 49 - 51).

9.7 Regarding claim 7, Sharood does not explicitly disclose the connector of any one of claim 1 to 3, wherein said protocol conversion connector has a position information storing memory in which positional information contained in the control signals, corresponding to said individual communication address is rewritably saved, said control signals being received at said primary connecting portion through said network or received at said secondary connecting portion from said network-adapted appliance. However, the Examiner takes official notice that storage of positional information is inherent in Sharood in order to locally save control information for multiple appliances.

9.8 Per claim 8, Sharood does not explicitly teach the connector of claim 4, wherein said protocol conversion connector has a position information storing memory in which positional information contained in the control signals, corresponding to said individual communication address is rewritably saved, said control signals being received at said

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primary connecting portion through said wireless communication server or received at said secondary connecting portion from said network-adapted appliance.

However, the Examiner takes official notice that storage of positional information is inherent in Sharood in order to locally save control information for multiple appliances.

9.9 Regarding claim 9, Sharood discloses the connector of one of claim 1 to 4, further comprising a power source conversion circuit which converts the voltage and/or current to be supplied to said network-adapted appliance from said feeder connecting portion (col. 9, lines 1 – 5 “The power supply 620 powers the retrofit plug's components (620, 630, and 640) by **converting the appliance AC voltage** (e.g., 100V to 264V and 50/60 Hz) to a5/10V DC voltage.”).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 703 305-8447. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

krc

KENNETH R. COULTER  
PRIMARY EXAMINER  
